

21-273-8300

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CENTRAL FAX CENTER****AUG 05 2005****IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**In re application of:  
Edward J. Petrus

Examiner: Rachel L. Porter

Serial No. 09/444,660

Group Art Unit: 2166

Filed: November 22, 1999

For: Dietary Supplement Selector and Method

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES****SUPPLEMENT TO BRIEF ON APPEAL**

Applicant responds to the Notification of non-complaint appeal brief mailed 7/29/05 as follows:

1. The brief does not contain a statement of the status of all claims, or does not identify the appealed claims.

Claims 1-5 were rejected under 35 U.S.C. § 112, 1<sup>st</sup> paragraph. The "examiners indicated that the removal of the phrase "for differences in" in the comparing of step (c) of claim 1 should be sufficient to overcome the rejection of claims 1-5 under 112, 1<sup>st</sup> paragraph provided in the Final Rejection mailed 12/22/04." Interview summary 2/15/05

Claims 1-5 were rejected under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph. "Examiners indicated that the removal of the phrases "other items covered by the questionnaire" and "other nutritional supplements" from steps c) and d) of claim 1 should be sufficient to overcome the 112, 2<sup>nd</sup> paragraph rejections of claims 1-5 provided in the Final Rejection mailed 12/22/04." Interview summary 2/15/05.

Claims 1-5 were rejected under 35 U.S.C. § 103(a). This rejection was the same rejection presented in the original appeal (App. No. 2003-2002) filed 4/4/03. The Appeal decision rendered on July 21, 2004, reversed the decision of the examiner to reject claims 1-5 under 35 U.S.C. § 103(a) and presented a new rejection under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph. A copy of the Appeal decision is attached to this Supplement.

2. At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment. See response to #1 and a copy of the

interview summary is attached.

3. The brief does not contain copies of the evidence submitted under 37 CFR 1.130, 1.131, 1.132 or any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered by the examiner, as an appendix thereto 37 CFR 41.37(c)(1)(ix).

37 CFR 1.130, 1.131 and 1.132 refers to affidavits or declarations - none exist.

4. The brief does not contain copies of the decisions rendered by a court or the Board in the proceeding identified in the Related Appeals and Interferences section of the brief as an appendix thereto.

A copy of the decision of the Board of Appeals is attached.

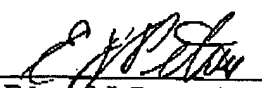
5. Other:

Claims 1-5 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In the Response to rejection after final, submitted on February 7, 2005, it was stated that Claims 1-5 were rejected because "there is no direct description of comparing for differences to standardized profiles to achieve optimal health and wellness." In the original description filed on 11/22/1999 the questionnaire information was entered and stored in the computer database "where it is compared to a health profile for a person of the consumer's age and health history background. Based on this comparison, a dietary supplement profile 3 can be generated that calculates the consumers personal nutritional needs of vitamins, minerals, amino acids, enzymes, herbs and other nutritional supplements to achieve optimal health and wellness." (Page 2, lines 12-19). Claim 1(c) was amended to delete "for differences in" comply with this objection.

In the Interview summary 2/15/05, the "examiners indicated that the removal of the phrase "for differences in" in the comparing of step (c) of claim 1 should be sufficient to overcome the rejection of claims 1-5 under 112, 1<sup>st</sup> paragraph provided in the Final Rejection mailed 12/22/04."

The claim 1 c) in the Appendix was corrected to match the Response to rejection after final submitted on 2/8/05.

Respectfully submitted,

  
Edward J. Petrus, M.D.

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Tel: (512)-454-6500  
Fax: (512)-453-0066  
August 5, 2005  
Appellant pro se

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### Appendix

#### Claims:

1. A method/process of creating a dietary supplement profile for an individual comprising:
  - a) completing a health questionnaire by an individual,
  - b) comparing of the questionnaire information by an individual to a health profile for a person of the individual's age and health history background in a computer data base,
  - c) comparing the individual's health information to standardized profiles based on age, sex, physical activity, dietary habits, past medical history to achieve optimal health and wellness,
  - d) generating a computer-implemented dietary supplement profile based on the individual's health information listing the vitamins, minerals, amino acids, enzymes, and herbs to achieve optimal health and wellness.
2. The method/process of creating a dietary supplement profile of claim 1, wherein step (b) comprises comparing the questionnaire information by the individual and information provided by a physical examination to a health profile for a person of the individual's age and health history background in a computer database.
3. The method/process of creating a dietary supplement profile of claim 1, wherein step (b) comprises comparing the questionnaire information provided by the individual and information provided by laboratory studies to a health profile for a person of the individual's age and health history background in a computer database.
4. The method/process of creating a dietary supplement profile of claim 1, further comprises adding a list of commercially available products that provide the dietary supplements listed to achieve optimal health and wellness.
5. The method/process of creating a dietary supplement profile of claim 1, further comprises adding a plan for weight management.

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 26

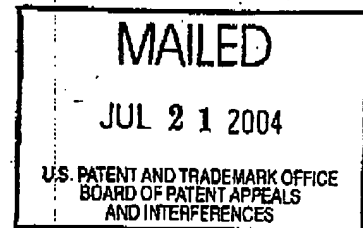
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte EDWARD J. PETRUS

Appeal No. 2003-2002  
Application No. 09/444,660

ON BRIEF



Before MCQUADE, BARRETT, and NASE, Administrative Patent Judges.  
MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Edward J. Petrus appeals from the final rejection of claims 1 through 5, all of the claims pending in the application.<sup>1</sup>

THE INVENTION

The invention relates to a method of creating a dietary supplement profile for an individual. Representative claim 1 reads as follows:

1. A method/process of creating a dietary supplement profile for an individual comprising:
  - a) completing a health questionnaire by an individual,
  - b) comparing of the questionnaire information by an individual to an optimal health profile in a computer data base,

<sup>1</sup> Claims 2 and 3 have been amended subsequent to final rejection.

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c) adjusting for differences in the individual's health information when compared to an optimal health profile,  
d) generating a computer-implemented dietary supplement profile based on the individual's health information listing the vitamins, minerals, amino acids, enzymes, and herbs suggested for an optimal health profile.

#### THE PRIOR ART

The references relied on by the examiner to support the final rejection are:

Summerell et al. (Summerell)	5,937,387	Aug. 10, 1995
Riley	5,976,568	Nov. 2, 1999

#### THE REJECTION

Claims 1 through 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Summerell in view of Riley.

Attention is directed to the main and reply briefs (Paper Nos. 17 and 21) and to the answer (Paper No. 20) for the respective positions of the appellant and the examiner regarding the merits of this rejection.<sup>2</sup>

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<sup>2</sup> In the final rejection (Paper No. 8), claims 2 and 3 also stood rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The examiner has since withdrawn this rejection in light of the amendment of claims 2 and 3 subsequent to final rejection (see the advisory action dated November 18, 2002, Paper No. 10).

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### DISCUSSION

#### I. Preliminary matters

The appellant (see pages 1 through 5 in the main brief) raises as issues in the appeal the propriety of (1) the examiner's decision to make "final" the Office action appealed from (Paper No. 8), and (2) the Technology Center Director's decision (Paper No. 12) to deny the appellant's 37 CFR § 1.181 petition (Paper No. 11) requesting withdrawal of the finality of such Office action. As these related matters are not directly connected with the merits of issues involving a rejection of claims, they are not reviewable by appeal to this Board (see In re Hengehold, 440 F.2d 1395, 1403-04, 169 USPQ 473, 479 (CCPA 1971)), and hence will not be further addressed in this decision.

#### II. The appealed rejection

We shall not sustain the standing 35 U.S.C. § 103(a) rejection of claims 1 through 5 as being unpatentable over Summerell in view of Riley. For the reasons expressed below, claims 1 through 5 are indefinite. Therefore, the standing prior art rejection must fall since it necessarily is predicated on speculative assumption as to the meaning of the claims. See In re Steele, 305 F.2d 859, 862-63, 134 USPQ 292, 295 (CCPA 1962). It should be understood, however, that our decision in

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this regard rests solely on the indefiniteness of the claimed subject matter and does not reflect on the adequacy of the prior art evidence applied in support of the § 103(a) rejection.

### III. New rejections

The following new rejections are entered pursuant to 37 CFR § 1.196(b).

Claims 1 through 5 are rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter the appellant regards as the invention.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In determining whether this standard is met, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

As indicated above, independent claim 1 recites a method/process of creating a dietary supplement profile of an



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individual comprising, inter alia, the steps of comparing an individual's health questionnaire information to an "optimal health profile" in a data base and "adjusting" for differences in the individual's health information when compared to the "optimal health profile." Read in light of the underlying disclosure, these recitations of the "optimal health profile" and the "adjusting" step render the scope of claim 1, and claims 2 through 5 which depend therefrom, indefinite. The underlying disclosure makes no mention of an "optimal health profile," and instead describes comparison of the questionnaire information to "a health profile for a person of the consumer's age and health history background" (specification, page 2) and/or to "standardized profiles based on age, sex, physical activity, dietary habits, past medical history and other items covered in the questionnaire" (specification, page 3). Neither of these descriptions reasonably depicts an "optimal health profile" or gives any indication as to what an "optimal health profile" might be. Similarly, the underlying specification makes no mention of any type of "adjusting" step corresponding to that recited in claim 1.

The scope of dependent claims 2, 3 and 4 is additionally indefinite in that it is unclear whether the recitations in

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claims 2 and 3 of "a health profile in a computer database" and in claim 4 of "an optimal health profile" refer to the "optimal health profile" recited in parent claim 1 or to some other health profile. With further regard to claim 4, the recitation of "the dietary supplements listed in an optimal health profile" is confusing in light of the description in the underlying specification that the dietary supplements are listed in the dietary supplement profile rather than in an optimal health profile.

Claims 1 through 5 also are rejected under 35 U.S.C. § 112, first paragraph, as being based on a specification which lacks a written description of the claimed invention.

The test for determining compliance with the written description requirement of the first paragraph of 35 U.S.C. § 112 is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

In the present case, the disclosure of the application as originally filed would not reasonably convey to the artisan that

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the appellant had possession at that time of a method/process of creating a dietary supplement profile of an individual comprising the steps of comparing questionnaire information to an "optimal health profile" in a data base and "adjusting" for differences compared to the "optimal health profile" as now recited in independent claim 1, or the step of providing "the dietary supplements listed in an optimal health profile" as now recited in dependent claim 4. As alluded to above in connection with the § 112, ¶ 2, rejection, the original disclosure makes no mention of an "optimal health profile," an "adjusting" step or the provision of "dietary supplements listed in an optimal health profile."

#### SUMMARY

The decision of the examiner to reject claims 1 through 5 is reversed, and new rejections of these claims are entered pursuant to 37 CFR § 1.196(b).

This decision contains new grounds of rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

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37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:


(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner; in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .


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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED; 37 CFR § 1.196(b).

  
JOHN P. MCQUADE  
Administrative Patent Judge

*Lee E. Barrett*  
LEE E. BARRETT  
Administrative Patent Judge

  
JEFFREY V. NASE  
Administrative Patent Judge

BOARD OF PATENT  
APPEALS AND  
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JPM/kis

<p align="center"><b>Interview Summary</b></p>	Application No. 09/444,660		Applicant(s) PETRUS, EDWARD J.	
	Examiner Rachel L. Porter		Art Unit 3626	

All participants (applicant, applicant's representative, PTO personnel):

(1) Rachel L. Porter. (3) Edward Petrus, Pro Se Applicant.

(2) Joseph Thomas, SPE. (4) \_\_\_\_\_

Date of Interview: 08 February 2005.

Type: a) ☒ Telephonic b) ☐ Video Conference  
 c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.  
 If Yes, brief description: \_\_\_\_\_

Claim(s) discussed: 1 in particular (all claims of record in general).


Identification of prior art discussed: n/a.

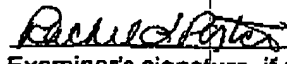
Agreement with respect to the claims f) ☐ was reached. g) ☐ was not reached. h) ☒ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: See Continuation Sheet.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

  
 JOSEPH THOMAS  
 SUPERVISORY PATENT EXAMINER  
 TECHNOLOGY CENTER 3600

  
 Examiner's signature, if required

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

Continuation Sheet (PTOL-413)

Application No. 09/444,660

Continuation of Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Discussed claim rejections under 112, 1st paragraph and 112,2nd paragraph and proposed amendments to overcome these claim rejections. Examiners indicated that the removal of the phrases "other items covered by the questionnaire" and "other nutritional supplements" from steps c) and d) of claim 1 should be sufficient to overcome the 112, 2nd paragraph rejections of claims 1-5 provided in the Final Rejection mailed 12/22/04. Examiners also indicated that removal of the phrase "for differences in" in the comparing step (c) of claim 1 should be sufficient to overcome the rejection of claims 1-5 under 112,1st paragraph provided in the Final Rejection mailed 12/22/04. Advised Applicant that any amendments to the claims at this stage must be submitted in a formal, signed After-Final written response .

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: ) Examiner: Rachel L. Porter  
Edward J. Petrus )  
Serial No. 09/444,660 )  
Filed: November 22, 1999 ) Group Art Unit: 3626  
For: Dietary Supplement Selector and Method

**RESPONSE TO REJECTION AFTER FINAL**

In response to the decision of the examiner mailed on December 22, 2004, please amend the claims as follows:

**Claim Amendments:**

1. (Currently amended) A method/process of creating a dietary supplement profile for an individual comprising:

- a) completing a health questionnaire by an individual,
- b) comparing of the questionnaire information by an individual to a health profile for a person of the individual's age and health history background in a computer data base,
- c) comparing for differences in the individual's health information to standardized profiles based on age, sex, physical activity, dietary habits, past medical history and other items covered in the questionnaire to achieve optimal health and wellness,
- d) generating a computer-implemented dietary supplement profile based on the individual's health information listing the vitamins, minerals, amino acids, enzymes, and herbs and other nutritional supplements to achieve optimal health and wellness.

2. (Previously amended) The method/process of creating a dietary supplement profile of claim 1, wherein step (b) comprises comparing the questionnaire information by the individual and information provided by a physical examination to a health profile for a person of the individual's age and health history background in a computer database.

3. (Previously amended) The method/process of creating a dietary supplement



profile of claim 1, wherein step (b) comprises comparing the questionnaire information provided by the individual and information provided by laboratory studies to a health profile for a person of the individual's age and health history background in a computer database.

4. (Previously amended) The method/process of creating a dietary supplement profile of claim 1, further comprises adding a list of commercially available products that provide the dietary supplements listed to achieve optimal health and wellness.

5. (Original) The method/process of creating a dietary supplement profile of claim 1, further comprises adding a plan for weight management.

#### REMARKS

1. Claims 1-5 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Claims 1-4 were rejected because "there is no direct description of comparing for differences to standardized profiles to achieve optimal health and wellness." In the original description filed on 11/22/1999 the questionnaire information was entered and stored in the computer database "where it is compared to a health profile for a person of the consumer's age and health history background. Based on this comparison, a dietary supplement profile 3 can be generated that calculates the consumers personal nutritional needs of vitamins, minerals, amino acids, enzymes, herbs and other nutritional supplements to achieve optimal health and wellness." (Page 2, lines 12-19). Claim 1(c) was amended to comply with this objection.

2. Claims 1-5 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 was amended to remove the phrases "and other items in the questionnaire" and "and other nutritional supplements." Step b of claim 1 compares the data in the questionnaire to that of

a person of the consumer's age and health history background. Step c of claim 1 compares the differences noted to standardized profiles based on age, sex, physical activity, dietary habits, and past medical history in the computer database. The database for that individual may notice changes from prior data to arrive at a new profile. Claim 2 may note a change in physical signs such as an increase or decrease in blood pressure. Claim 3 may note a change in lab studies such as an increase in CRP. Claim 4 will then provide a different profile and suggested dietary supplements.

3. Claims 1-5 were rejected under 35 U.S.C. §103(a) as being unpatentable over Summerell et al (USPN 5,937,387) in view of Riley (USPN 5,976,568).

This rejection was thoroughly discussed in the Brief on Appeal pages 6-10 and Reply Brief pages 1-7.

#### CONCLUSION

For all the above reasons, Applicant submits that the claims are now in proper form, and that the claims all define patentable over the prior art. Applicant submits this application is now in condition for allowance, which action is respectfully petitioned.

Respectfully submitted,



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Applicant Pro Se

February 7, 2005

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